

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/117,363 | 09/03/93 | COOK | P 1SISI169 |

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18M2/0107

EXAMINER
HOOTTERMAN, S

ART UNIT 1807 PAPER NUMBER

DATE MAILED: 01/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|---------------------------------------|------------------------------------|
| Office Action Summary | Application No. 08/117,363 | Applicant(s) Cook et al. |
| | Examiner Scott W. Houtteman | Group Art Unit 1807 |

Responsive to communication(s) filed on Oct 14, 1997

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-29 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit 1807

1. Applicant's response, filed 10/14/97, has been carefully considered with the following effect:

The objection and rejections of paragraphs 5, Office action mailed 6/10/97, have been withdrawn in view of applicant's amendments and arguments.

The objections and rejections of paragraphs 4 and 6-8, Office action mailed 6/10/97, have been maintained.

2. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to: **Art Unit: 1807; Examiner: Scott Houtteman.**

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-19 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-29 of copending Application No. 08/464,953. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5. Claims 1-4, 6-18 and 20-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Urdea et al., US Pat. 4,910,300, 3/1990 (Urdea) in view of Carico, US Pat. 4,743,535,

5/1980, Matteucci et al. WO 92/05186, 4/92 (Matteucci) and Latham et al., WO 91/14696, 10/91 (Latham).

6. Claims 5 and 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Urdea, Carico, Matteucci and Latham as used above, and further in view of applicants admissions.

7. Applicant argues that the Urdea teaches a hydrogen or a blocking group and not an amine group and thus the rejection should be withdrawn. This argument is not persuasive. Even if, for argument's sake, one were to accept that Urdea teaches only the presence of a blocking group added to the 2' atom of a nucleotide, the rejection is still valid.

All the references taken in combination would still suggest the claimed invention. Note in particular that Matteucci alone discloses a nitrogen group in the proper orientation relative to the atoms in the linkage, O-C-N, and Latham teaches attachment at the 2' position of the sugar.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

9. This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8, 1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or

365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a first submission and the appropriate fee of \$790 for a large entity under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

10. Papers relating to this application may be submitted to Group 1800 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1800 Fax numbers are (703) 305-3014 and 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Houtteman whose telephone number is (703) 308-3885. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 5:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Scott Houtteman
January 5, 1998


SCOTT W. HOUTTEMAN
PRIMARY EXAMINER
GROUP 1800